



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,987	12/31/2001	Stephane H. Maes	YOR920010471US1(8728-534)	9604
7590	08/25/2004		EXAMINER	
F. CHAU & ASSOCIATES, LLP Suite 501 1900 Hempstead Turnpike East Meadow, NY 11554			WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,987	MAES, STEPHANE H.	
	Examiner	Art Unit	
	Jalatee Worjoh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 28-33 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/2001.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 28-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on “Response to Restriction Requirement” dated 07/16/2004.
2. Applicant's election with traverse of Invention I in the reply filed on 7/16/2004 is acknowledged.
3. The traversal is on the ground(s) that “there would be no serious burden on Examiner to simultaneously examination of claims of Group I and II”. This is not found persuasive because the examiner believes that the restriction is proper since the subcombinations are distinct, each from the other, and are shown to be separately usable. Invention II (claims 28-33) has separate utility such as performing a secure function computation of an electronic copy, which is classified as 705/50; whereas, Invention I is classified as 705/75. Thus, the examiner notes that it would be a serious burden to search both inventions given their separate status in the art as noted above.

The requirement is still deemed proper and is therefore made FINAL.

Applicant has provisionally elected Group I (Claims 1-27); consequently, an examination of the merits of these claims is included below.

4. Claims 1-27 have been examined.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 26 recites the limitation "the notification message" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 6-8, 10-16, 18, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5903878 to Talati et al.

Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant"), sending by the second party, a request for confirmation of the electronic transaction to a predetermined, private mailbox (i.e. ECS) associated with the first party (see col. 10, lines 53-67), accessing the private mailbox by the first

Art Unit: 3621

party (see col. 11, lines 2-4) and sending, by the first party, a reply message to the request for confirmation to thereby confirm authorization of the electronic transaction (see col. 11, lines 11-21).

Referring to claim 2, Talati et al. does not explicitly disclose the step of sending a request for confirmation comprises the step of contracting, by the second party, a third party service provider to obtain the location of the predetermined, private mailbox. However, this is an inherent step; that is, the merchant contracts the third party (i.e. CA), who in turns transmits the confirmation message to the client. Before transmission of the message the mailbox location must first be obtained (see col. 10, lines 53-57).

Referring to claims 6 and 8, Talati et al. disclose sending a reply message comprises sending an e-mail message to a predetermined location (i.e. CA at the ECS); wherein the step of sending a reply message comprises forwarding the confirmation message to a predetermined location (see col. 11, lines 11-20).

Referring to claim 7, Talati et al. disclose the e-mail message comprises a confirmation code (i.e. "UTID") provided in the notification message (see col. 10, lines 30-36).

Referring to claims 10 and 22, Talati et al. disclose accessing the private mailbox comprises authenticating the identity of the first party to access the private mailbox (see col. 10, lines 61-67; col. 11, lines 1-3).

Referring to claim 11, Talati et al. disclose authenticating the identity of the first party comprises performing biometric (i.e. signature) authentication of the first party (see col. 6, lines 25-32).

Referring to claim 12, Talati et al. disclose authenticating the identity of the first party comprises providing a predetermined PIN (personal identification number) or password of the first party (see col. 10, liens 64-67; col. 11, lines 1,2).

Referring to claims 13 and 23, Talati et al. disclose the step of encoding the confirmation request and reply message (see col. 10, lines 61-64).

Referring to claims 14 and 15, Talati et al. disclose the private mailbox comprises a messaging system; wherein the messaging system comprises one of e-mail, short messaging, multimedia messaging, instant messaging, voice mail and universal messaging system (see col. 10, lines 10-13 and col. 11, lines 11-20).

Referring to claim 16, Talati et al. disclose the private mailbox comprises a post office box and the confirmation is send via snail mail (see col. 1, lines 56-59).

Referring to claim 18, Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant"), providing, by the second party to the third party service provider (i.e. "CA"), a request for confirmation of the electronic transaction, sending, by the third party service provider, the request for confirmation of the electronic transaction to a predetermined, private mailbox (i.e. ECS) associated with the first party (see col. 10, lines 53-67), accessing the private mailbox by the first party (see col. 11, lines 2-4) and sending, by the first party, a reply message to the request for confirmation to thereby confirm authorization of the electronic transaction (see col. 11, lines 11-21). The step of providing, by the first party to the second party, contract information of a third party service provider associated with the first party is an inherent step; that is, in order for the second party to

Art Unit: 3621

provide information to the third-party, the second party must have received contact information of the third party.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-5,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. as applied to claims 1 and 18 above, and further in view of US Publication No. 2001/0037464 to Persels et al.

Referring to claims 3 and 19, Talati et al. disclose sending a notification of newly received email messages (see col. 10, lines 10-15). Talati et al. do not expressly disclose sending notification to the first party of a pending request for confirmation. Persels et al. disclose sending notification to the first party of a pending request for confirmation (see paragraph [0020]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the notification disclosed by Talati et al. to inform the receiver of pending confirmation request. One of ordinary skill in the art would have been motivated to do this because it provides adequate customer services by informing the first party of pending confirmation request.

Referring to claim 4, Talati et al. disclose the method wherein the notification comprises a confirmation code (i.e. “UTID”) to be provided in the reply message (see col. 10, liens 53-60; col. 11, liens 27-32).

Referring to claims 5 and 20, Talati et al. disclose the method wherein the step of sending notification comprises sending a notification message by the second party to a predetermined messaging location of the first party other than the private mailbox of the first party (see col. 10, lines 53-60).

12. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. as applied to claims 1 and 18 above, and further in view of US Publication No. 2001/004050 to Fletcher et al.

Talati et al. disclose sending a confirmation request (see claim 1 above). Talati et al. do not expressly disclose imposing a time period in which the first party must confirm authorization of the electronic transaction. Fletcher et al. disclose imposing a time period in which the first party must confirm authorization of the electronic transaction (see paragraph [0054]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include the step of imposing a time period in which the first party must confirm authorization of the electronic transaction. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating transaction delays.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. as applied to claim 1 above, and further in view of US Publication No. 2003/0018572 to Beschle et al.

Art Unit: 3621

Talati et al. disclose the private mailbox (see claim 1 above). Talati et al. do not expressly disclose the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message. Beschle et al. disclose the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message (see paragraph [0055]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message. One of ordinary skill in the art would have been motivated to do this because it provides additional means for sending the confirmation message.

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. as applied to claim 18 above.

Talati et al. disclose a second party and third party (see claim 18 above). Talati et al. do not expressly disclose the second party and third party service provider are the same entity. However, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include the second and third party as the same entity. One of ordinary skill in the art would have been motivated to do this because it makes the transaction process faster by eliminating an additional entity.

15. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. in view of Fletcher et al.

Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant") and sending by the second party, a confirmation

message of the electronic transaction to a predetermined, private mailbox (i.e. ECS) associated with the first party (see col. 10, lines 53-67). Talati et al. do not expressly disclose wherein the electronic confirmation is deemed confirmed if a reply message denying the transaction is not sent by the first party within a predetermined period of time. Fletcher et al. disclose imposing a time period on the delivered mail (see paragraph [0054]). The examiner notes that Fletcher teaches the overall process of including a timer in the delivered request; thereby, any other conditions (i.e. the confirmation being deemed confirmed) can be implied. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Fletcher et al. to include the step wherein the electronic confirmation is deemed confirmed if a reply message denying the transaction is not sent by the first party within a predetermined period of time. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating transaction delays.

Referring to claim 26, Talati et al. disclose sending a notification of newly received email messages (see col. 10, lines 10-15). Talati et al. do not expressly disclose a notification message provides information regarding the predetermined period of time. Fletcher et al. disclose a notification message provides information regarding the predetermined period of time (see paragraph [0054]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include a notification message that provides information regarding the predetermined period of time. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating response delays.

Art Unit: 3621

Referring to claim 27, Talati et al. does not explicitly disclose the step of sending a request for confirmation comprises the step of contracting, by the second party, a third party service provider to obtain the location of the predetermined, private mailbox. However, this is an inherent step; that is, the merchant contracts the third party (i.e. CA), who in turns transmits the confirmation message to the client. Before transmission of the message the mailbox location must first be obtained (see col. 10, lines 53-57).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450*

Art Unit: 3621

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.

August 11, 2004

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2300